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10/551,880

09/30/2005

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2725-27006

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EXAMINER

BATES, ZAKIYA W

ART UNIT

PAPER NUMBER

3676

MAIL DATE

DELIVERY MODE

02/02/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

The finality of the previous Office Action has been withdrawn due to further search and consideration.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 521-528, 531-537, 539-545, 547-565, 567-577, and 580-615 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Ring et al. (US 2005/0056433 cited by applicant).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Ring et al. discloses, with respect to claim 21, an apparatus for cutting a tubular member, comprising: a support member; a plurality of movable cutting elements coupled to the support member; an actuator coupled to the support member for moving

Art Unit: 3676

the cutting elements between a first position and a second position; and a sensor coupled to the support member for sensing the internal diameter of the tubular member; wherein in the first position, the cutting elements do not engage the tubular member; wherein in the second position, the cutting elements engage the tubular member; and wherein the sensor prevents the cutting elements from being moved to the second position if the internal diameter of the tubular member is less than a predetermined value. With respect to the remaining claims, the reference teaches the limitations as claimed, including sensors [0225-0226], grippers, cutting elements, gripping elements. (See the figures).

Response to Arguments

3. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Simpson (US 6598678 cited by applicant) teaches an apparatus for expanding/deforming a tubular and cutting the tubular.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Zakiya W. Bates/ whose telephone number is (571) 272-7039. The examiner can normally be reached on Monday-Friday, 8:30 AM-5 PM.

Art Unit: 3676

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer Gay can be reached on (571) 272-7029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Zakiya W. Bates/
Primary Examiner
Art Unit 3676

zb
1/29/09